

REMARKS

I. Status of the Claims

At the outset, Applicants presume that Examiner Fox entered Applicants' amendments dated October 4, 2007, and that therefore the strike-outs and underlined added text depicted in present claim 3 are made on that presumption.

With that in mind, Applicants assert that claims 3, 5, and 44-55 and 58-60 are currently pending. Claims 1-2, 4, 6-13, 14-43, 56, and 57 are canceled without prejudice or disclaimer and purely to help expedite an allowance. Applicants reserve the right to file one or more continuing applications to the canceled subject matter.

Applicants sought to capture their inventive technology concerning nucleotide sequences that are dissimilar to *Agrobacterium* T-DNA border sequences but which nevertheless help to promote and facilitate integration of a co-joined polynucleotide. Applicants therefore apologize that their October 4th amendment introduced more consensus sequences than Examiner Fox had expected ("[S]uch an amendment to introduce multiple consensus sequences and sequence variants was not invited by the Examiner," Office Action/Restriction at page 2). Examiner Fox therefore now requires Applicants to "select a single nucleotide sequence, *i.e.*, one of SEQ ID NOS: 47, 93, 113, 115, and 117," *Id.*

Applicants have therefore amended claim 3 to capture 25-nucleotide-long sequences that comprise the consensus sequence depicted in SEQ ID NO:93. Please see paragraphs [0158] and [0219] of the application for support ("the present invention encompasses any border-like sequence that has the nucleic acid sequence structure of SEQ ID NO. 93: ANGATNTATN6GT (SEQ ID NO. 93), where "N" is any nucleotide, such as those represented by "A," "G," "C," or "T." This sequence represents the consensus sequence of border-like nucleic acids identified by the present invention").

Applicants also amend claim 3 to claim a variant sequence described as a nucleotide sequence that comprises the consensus sequence of SEQ ID NO:93 but wherein 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, or more nucleotides of the nucleotide sequence are different from a T-DNA border sequence from an *Agrobacterium* species. Please see paragraph [0047] for support for this amendment.

New claim 60 is added to qualify the functionality of the claimed 25-nucleotide-long sequence (i.e., that it “promotes and facilitates integration” of a co-joined desired polynucleotide), as comprising a recognition site for a virD2 enzyme. Please see paragraph [0213].

Since none of these amendments or added embodiments introduces new matter, Applicants respectfully request their entry into the record.

Applicants acknowledge Examiner Fox’s statement that the amendments and arguments they filed on February 20, 2007 “have overcome the outstanding indefiniteness and new matter rejections” (page 2), but that certain other rejections are maintained. Applicants believe that the amended claims address and overcome these remaining rejections for the reasons that follow below, which are essentially the same as those presented in Applicants’ October 4, 2007, paper, albeit now tailored to the consensus of SEQ ID NO: 93.

II. The claims recite a genus of sequences falling under the consensus sequence of SEQ ID NO:93 and are therefore supported by the written description

Claims 3, 5, 13, and 44-55 were previously rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. Office action dated November 20, 2007, at page 2. Examiner Fox had previously concluded that there is “no particular consensus sequence of any length” recited in the claims and that “the claims do not recite a genus of sequences which is commensurate in scope with what was exemplified.” Please see page 4 of that office action.

To expedite examination and to help advance this case toward allowance, however, and as explained above, Applicants have amended the claims to (1) recite sequences of a particular length (25 nucleotides) and (2) consensus sequence, as denoted by sequence identifier 93, and to (3) clarify that these sequences are not 100% identical to a T-DNA border. Written description support for these consensus sequences is found explicitly in the specification as Applicants pointed out in the preceding subsection. Functionally, these sequences, or the claimed variants thereof, are required to promote and facilitate the integration of the desired polynucleotide into the plant genome, such as by serving as a recognition site for a virulence enzyme.

Applicants believe that these amendments fully characterize the claimed sequence in terms of its length, its core or underlying consensus sequence, its dissimilarity to known *Agrobacterium* T-DNA borders, and its functionality. All of these embodiments were written in the specification and in Applicants' possession at the time of filing. For these reasons, Applicants believe that the written description rejection is moot and respectfully request its withdrawal.

III. The claims recite the length and underlying consensus sequence for the integrative nucleotide sequence and are enabled

Claims 3, 5, 13 and 44-55 were rejected under 35 U.S.C. § 112, first paragraph as non-enabled for claims broadly drawn to any sequence of any length for transferring foreign DNA into heterologous plants. Office action at pages 2-3. Examiner Fox acknowledges the claims are enabled "for claims limited to methods of using 25 base pair-long P-DNA borders from plants comprising the consensus sequence of SEQ ID NO: 47." *Id.*

Applicants believe that the amended claims, which qualify the length of the claimed sequence as 25 base pairs-long and which are amended to recite the consensus of SEQ ID NO: 93, addresses this concern. Applicants therefore believe the claims are enabled and respectfully request withdrawal of this rejection.

IV. The rejection based on McElroy is moot since claim 13 is canceled herein

Claim 13 was rejected under 35 U.S.C. § 102(e) as allegedly anticipated by United States Patent No. 6,750,379 ("McElroy"). Office action at page 5. The Office's position is that "claim 13 does not stipulate that the 5-100 nt portion of the integrative sequence not be identical to a T-DNA border sequence." *Id.*

Purely to expedite examination, Applicants have canceled claim 13 without prejudice or disclaimer. Accordingly, this rejection is moot.

CONCLUSION

Applicants believe that the present application is in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date January 28, 2008
FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5483
Facsimile: (202) 672-5399

By V.S. Mohan-Ram
Richard C. Peet
Attorney for Applicant
Registration No. 35,792

Vid S. Mohan-Ram
Registration No. 55,459